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OF THE TTAB

Mailed: February 24, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Fabiano's Sweet Shoppe, LLC
v.
Fabiano's Homemade Candies, Inc.

Opposition No. 91151432
to applicant Serial No. 76268054
filed on June 7, 2001

Malcolm L. McKinnon of McKinnon & McKinnon for Fabiano's Sweet Shoppe, LLC.

James R. Duby, Jr. of Gallagher Duby, PLC for Fabiano's Homemade Candies, Inc.

Before Hohein, Walters and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Fabiano's Homemade Candies, Inc. (a Michigan corporation) filed an application on June 7, 2001, to register the mark FABIANO'S on the Principal Register for "homemade candies" in International Class 30. Applicant's claimed date of first use anywhere and first use in commerce is May 31, 1984. Following a refusal to register under Section 2(e)(4) of the Trademark Act on the basis that the

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mark is primarily merely a surname, applicant amended its application to seek registration pursuant to Section 2(f) of the Trademark Act, based on applicant's declaration of over 17 years of its substantially exclusive and continuous use of the mark in commerce.

In its pleading, opposer, Fabiano's Sweet Shoppe, LLC (a Michigan limited liability company), relies on common law rights, asserting priority of use and likelihood of confusion under Section 2(d) of the Act, 15 U.S.C. §1052(d). More specifically, opposer alleges that it and its predecessors in interest have used the name and mark FABIANO'S in connection with retail store services featuring ice cream, candy and confections continuously since a time prior to applicant's first use and well before applicant's filing date; that opposer has established valuable goodwill in its name and mark through its substantial advertising and promotional efforts; that opposer has achieved strong sales; that opposer has received significant press and publicity; that opposer's name and mark became well known to consumers before applicant's alleged date of first use of its mark; and that applicant's mark, when used on applicant's goods, so resembles opposer's name and mark as to be likely to cause confusion or to cause mistake or to deceive as to the source or sponsorship of the goods in question.

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The other grounds for opposition pleaded by opposer are that the primary significance of the mark "FABIANO'S" to the purchasing public is merely a surname;¹ and that applicant's mark consists of a name identifying a particular living individual, Jane Fabiano, who has not given her written consent to applicant to register the name as a mark, but instead has given written consent to opposer to use and register the name as a mark.

In its answer, applicant denies each of the allegations of the notice of opposition, and asserts the affirmative defenses of estoppel, laches, acquiescence and unclean hands.² In addition, applicant asserts in its affirmative defenses (paragraph 1) that opposer's claims against applicant are barred because opposer cannot establish priority of use of the name FABIANO'S as opposer's first use is on or about April 3, 2000; that "confusing similarity exists between Opposer's name FABIANO'S and the Applicant's mark"; and that opposer's junior use of the name FABIANO'S on its goods is likely to cause confusion with applicant's use of its mark. Such allegations are not an "affirmative

¹ In light of the fact that applicant seeks registration under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), it is presumed that opposer is contending that the mark has not acquired distinctiveness as identifying applicant as the source of the goods.

² Applicant, however, neither submitted evidence during trial nor argued in its brief about the affirmative defenses of estoppel, laches, acquiescence and unclean hands. Therefore, those defenses will not be further considered herein.

defense," but rather are in the nature of further denials of opposer's claim of priority.³

The record consists of the pleadings; the file of applicant's application; opposer's testimony, with exhibits, of (i) Kathleen Ghinelli, co-owner of opposer, (ii) Gina Ghinelli-Mulcahy, co-owner of opposer, (iii) Jane Fabiano, a co-founder of the original FABIANO'S HOMEMADE CANDIES store and (iv) Paul Ghinelli, Jane Fabiano's grandson, who opened a store in 1997; and applicant's testimony, with exhibits, of Madeline Blair, president of applicant.

Both parties filed briefs on the case.⁴ Neither party requested an oral hearing.

³ Applicant requested in the prayer for relief in its answer to the notice of opposition that the Board refuse registration of opposer's pending application Serial No. 76330434 (filed October 26, 2001 for the mark FABIANO'S for "retail store services featuring homemade ice cream, candy and confections") on the basis of likelihood of confusion. The Board has no jurisdiction over opposer's application which is currently in a suspended status in Law Office 111. Thus, applicant's request is denied.

⁴ Opposer's brief was timely filed on March 11, 2004. Applicant's brief was timely filed on April 12, 2004 (via certificate of Express Mail), indicating proof of service on opposer's attorney by first class mail on that date. Opposer's reply brief was due on April 27, 2004. See Trademark Rule 2.128(a)(1). On May 17, 2004 opposer filed a "Declaration Regarding Untimely Receipt of [Applicant's Brief]" in which opposer's attorney states that his office did not receive applicant's brief until May 3, 2004, which was a date after opposer "could timely file a Reply Brief." Opposer did not file either a motion to allow opposer further time to file a reply brief, or a reply brief with a motion that it be accepted. In fact, opposer did not indicate in any way that it intended to file a reply brief. Opposer did not make any request that the Board take any action regarding opposer's time to file a reply brief. Thus, the Board has not done so.

Family and Store History

This case is a family affair with two sides of the same family asserting rights in the mark FABIANO'S for homemade candies. Michael Fabiano worked for General Motors, Oldsmobile division, but he and his wife Jane occasionally operated a candy store for a few years at a time in the 1940s and 1950s. Then, in 1980 (after he retired from General Motors), Michael and Jane Fabiano purchased "Spagnuolo's" candy company located in Lansing, Michigan, and changed the name to FABIANO'S HOMEMADE CANDIES. Michael and Jane Fabiano made and packaged their own candy. Their family helped out over the years, including during busy holiday seasons (e.g., Christmas, Valentine's Day) and when Michael Fabiano was ill. Michael and Jane Fabiano operated the store until 1984 when they sold the business to their daughters, Madeline Blair and Kathleen Ghinelli. Specifically, the February 1984 bill of sale document shows that for \$24,000 sellers sold to the buyers "all the right, title and interest of the Sellers in all of the inventory and stock of merchandise, name, furniture, fixtures, machinery, equipment (except dipping equipment) and goodwill used in and pertaining to the business presently known as FABIANO'S HOMEMADE CANDIES..." The daughters, as the buyers, signed a promissory note that the \$24,000 including 7% annual interest would be paid at \$250.00 per month

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commencing March 1, 1984. (Kathleen Ghinelli dep., Exh. 1; see also, Madeline Blair dep., Exh. 1.) (These documents from 1984 were prepared by Michael and Jane Fabiano's attorney.)

The sisters operated the store as a partnership (without a written contract) until 1995 when, due to the growth of the business, the sisters incorporated as "Fabiano's Homemade Candies, Inc." (applicant) with 50% of the stock issued to each of the two sisters, and each one being an officer/director of the corporation. In that year applicant opened a second store in Lansing, Michigan. (Madeline Blair dep., Exh. 5.)⁵

On April 18, 2000, Kathleen Ghinelli sold all of her shares (50% of the shares of applicant corporation) to her nephew Steve Blair (Madeline's son) for \$50,350. By the terms of the "Stock Sale Agreement," Kathleen agreed to immediately resign from her position as a director and officer and terminate her status as a shareholder of the corporation. The agreement states that "the sole purpose of this agreement is to efficiently terminate the shareholder, director, officer, and employment relationship between [Kathleen Ghinelli and Fabiano's Homemade Candies, Inc.]."

⁵ Also in 1995, the sisters, as a separate partnership (again with no written contract), purchased a building, moved candy making equipment there and began candy-making operations under the name FABIANO'S CANDY KITCHEN. (Madeline Blair dep., pp. 27-

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This "Stock Sale Agreement" refers therein to a "Partnership Interest Sale Agreement," also dated April 18, 2000, between Fabiano's Candy Kitchen (the second partnership between the sisters) and Steve Blair and Kathleen Ghinelli. By the terms of the "Partnership Interest Sale Agreement," Kathleen Ghinelli sold to Steve Blair the entirety of her 50% interest in the partnership. There were two addendums to this partnership sale agreement, one of which provides, inter alia, that the partnership will be considered dissolved as of January 1, 2000 and that both Kathleen Ghinelli and Madeline Blair quitclaimed their ownership interest in the real estate of Fabiano's Candy Kitchen partnership to Fabiano's Candy Kitchen, LLC and they assigned their interests in the partnership to Fabiano's Candy Kitchen, LLC. (Kathleen Ghinelli dep., pp. 19-23, Exhs. 2 and 3, and Madeline Blair dep., pp. 35-38, Exhs. 8-10.) Kathleen Ghinelli testified that she later acquired an interest in opposer company in late 2000, a few months after she sold her stock in applicant corporation to Steve Blair. (Dep., p. 19.)

From mid 1996 to early 1997, Paul Ghinelli (Kathleen's son and Madeline's nephew) worked as a candy cook for applicant, Fabiano's Homemade Candies, Inc. After discussions with family members, including his grandparents,

28.) Kathleen Ghinelli later in 2000 sold her entire interest in

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his mother and his aunt (Madeline Blair), on February 10, 1997, Paul Ghinelli opened a store in Williamston, Michigan, selling candy and ice cream under the name FABIANO'S HOMEMADE CANDIES AND ICE CREAM.⁶ According to Paul Ghinelli, he wanted to "get into the ice cream business," but there were no written agreements about his use of the Fabiano name (dep., pp. 6-7). Applicant Fabiano's Homemade Candies, Inc., and his aunt, Madeline Blair, provided assistance to him in opening his store (so that it could open before Valentine's Day) in particular, supplying him with the candy and with candy boxes bearing applicant's name thereon. In addition, he testified that his store's address was included in applicant's yellow pages telephone book listings from 1997 through 2000 (Exhs. 5-8), as well as in advertisements (Exh. 9). About four months after his store opened, at his aunt's request, he changed the name of his store to FABIANO'S HOMEMADE ICE CREAM AND CHOCOLATES. (Dep., pp. 8-10.)

According to Madeline Blair, the family simply wanted to help Paul generally and to help him get his store open by Valentine's Day without him having to establish credit. Applicant was also attempting to control the use of the name

this partnership.

⁶ Kathleen Ghinelli testified that both she and her sister, Madeline Blair, granted Paul permission to use the name FABIANO'S. (Dep., pp. 14-15.)

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FABIANO'S, and it was for those reasons that applicant made candy and ordered boxes for Paul Ghinelli. She specifically

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testified that she spoke with her nephew Paul Ghinelli about opening a store in Williamston and told him it was a good idea, but he did not indicate the name he would use; that he later said his grandfather (Michael Fabiano) had said it was ok to use the Fabiano name and that she felt she could do nothing about it at that point; and that she tried to control the nature and quality of the goods by providing him with candy and packaging therefor, and advertisements. (Dep., pp. 39-41).

On April 8, 2000, Paul Ghinelli executed a bill of sale to Fabiano's Sweet Shoppe, LLC (opposer) for the price of \$22,500 which reads, in relevant part, as follows:

"...all the seller's rights, title, and interests in the following property:

See attached list

This property is presently located on the premises commonly known as Fabiano's Homemade Ice Cream and Candy..."

(Paul Ghinelli dep., Exh. 11. The "attached list" was not made of record.)

This was essentially a sale of Paul Ghinelli's Williamson, Michigan store to his sister Gina Ghinelli-Mulcahy, who is now a co-owner (with her mother, Kathleen Ghinelli) of opposer company. Opposer makes and sells homemade chocolates and homemade ice cream at that store. Opposer has filed a trademark application to register the

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mark FABIANO'S for "retail store services featuring homemade ice cream, candy and confection." (See e.g., Gina Ghinelli-Mulcahy dep., p. 8.) Opposer advertises in local newspapers (in Williamston and Lansing) and on local radio and television. Opposer has a website "when it's working" and the website has been up "on and off" for two years. (Gina Ghinelli-Mulcahy dep., p. 13.) Opposer spends \$20,000 annually on advertising and promotional matters. (Gina Ghinelli-Mulcahy dep., p. 12.) According to Gina Ghinelli-Mulcahy, since opposer opened in April 2000, opposer's sales have "been good," growing "a little bit each year" and they doubled in the most recent year (2002-2003). (Gina Ghinelli-Mulcahy dep., p. 24.)

Paul Ghinelli currently owns a corporation named Fabiano's Homemade Ice Cream and Chocolates, which was formed sometime in 2000--after he sold his Williamston store. (Paul Ghinelli dep., pp. 24-25.)

The three entities, applicant, opposer and Paul Ghinelli's corporation, all use similar boxes and packaging for chocolates. (Madeline Blair dep., p. 25, Exhs. 2 and 3 showing FABIANO'S HOMEMADE CANDIES in an oval; Gina Ghinelli-Mulcahy dep., pp. 12-13, Exh. 12 showing FABIANO'S SWEET SHOPPE in an oval; and Paul Ghinelli dep., pp. 25-26, Exh. 10 showing FABIANO'S HOMEMADE CANDIES in an oval.)

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Applicant, Fabiano's Homemade Candies, Inc., filed its application to register the mark FABIANO'S on June 7, 2001; and on May 30, 2001, Madeline Blair as "Authorized Winding Up Partner" of Fabiano's Homemade Candies Inc. executed a nunc pro tunc assignment of rights in the mark FABIANO'S from the original 1984 partnership to applicant, Fabiano's Homemade Candies, Inc. The assignment was recorded with the Assignment Branch of the USPTO on June 21, 2001. (Madeline Blair dep., Exh. 7.)

On August 7, 2001, Jane Fabiano (co-owner of the FABIANO'S HOMEMADE CANDIES store from 1980-1984), executed a "Consent To Register Name As a Trademark/Service Mark" to opposer, Fabiano's Sweet Shoppe, LLC, "to use the name Fabiano's and to seek to register of [sic] a trademark/service mark for use in the field of manufacturing and retailing of candy, confections and/or ice cream. ..." (Jane Fabiano dep., Exh. 4.)

On July 17, 2001 (approximately 5 weeks after filing the application involved herein), applicant sent cease and desist letters to: (i) opposer, Fabiano's Sweet Shoppe -- Gina Ghinelli, in Williamston, Michigan; (ii) Fabiano's Homemade Ice Cream & Chocolates -- Keith Van Noord and Paul Ghinelli, in Grand Rapids, Michigan; and (iii) Fabiano's Homemade Ice Cream & Chocolates -- Paul Ghinelli, in Lansing, Michigan. (Madeline Blair dep., Exhs. 11-13.)

There are no other documents of record relating to title or ownership of the mark, and both parties' witnesses essentially testified that several of the arrangements between different members of the family were not reduced to any written agreements.

Opposer's Position

Opposer essentially contends that Michael and Jane Fabiano owned the business name FABIANO'S HOMEMADE CANDIES for their candy store; that they sold this trade name and appurtenant goodwill, but they did not sell their surname FABIANO'S⁷ to their daughters, Kathleen Ghinelli and Madeline Blair, in 1984; that neither Kathleen Ghinelli nor Madeline Blair formally assigned to either their 1984 partnership or their 1995 corporation the interest they obtained in 1984 in the name FABIANO'S HOMEMADE CANDIES; that in 1997 Paul Ghinelli (one of opposer's predecessors-in-interest) received consent or permission from applicant corporation (including the permission of both Madeline Blair and Kathleen Ghinelli) to use the mark FABIANO'S for his independent store in Williamston, Michigan; that applicant acquiesced and ratified the grant to Paul Ghinelli by its actions of placing advertisements and yellow pages listings which included Paul Ghinelli's store listed therein; that

⁷ FABIANO'S is, of course, the possessive form of the surname "Fabiano." Both parties refer to FABIANO'S as the surname and for the sake of simplicity, we will do likewise.

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Paul Ghinelli sold his store to his sister, Gina Ghinelli-Mulcahy, in 2000, and she received verbal consent from both applicant and the family matriarch, Jane Fabiano, to use the mark FABIANO'S in conjunction with her business, Fabiano's Sweet Shoppe, LLC; that while Kathleen Ghinelli sold her shares in the corporation in 2000, she did not ever execute a conveyance of her interest in the name/mark FABIANO'S as conveyed to her in 1984; and that applicant's chain of title is defective and the record negates the single source attributes necessary for applicant to obtain federal registration.

From this interpretation of the events since 1980, opposer concludes that it has priority of use of the mark, essentially because opposer asserts that its rights are derived from and through Michael and Jane Fabiano, Kathleen Ghinelli, Paul Ghinelli, as well as through applicant, who acquiesced and ratified the use of the mark.

Opposer also concludes that (i) FABIANO'S is primarily merely a surname, which has not acquired distinctiveness as a mark because it is not associated with a single source;⁸

⁸ Opposer contends that not only is there use by both applicant and opposer of the same mark, but that another branch of Michael Fabiano's family (cousins) have used the mark since around 1903 in Holland, Michigan for a candy store. Kathleen Ghinelli testified that she went to Holland, Michigan to talk to the cousins about seeking their permission to use the mark and they granted verbal permission. (Kathleen Ghinelli dep., pp. 24-25.) However, Madeline Blair was specifically asked if the Holland, Michigan branch of the family stopped using FABIANO'S and she replied that the cousins do not use the mark FABIANO'S as they

and (ii) it is Jane Fabiano who has attained recognition in the field and the relevant public associates the name with her, and thus, the mark FABIANO'S identifies her as a particular living individual, but she has not given applicant her written consent to register the mark.

In the "Conclusion" portion of opposer's brief (pp. 22-23), it asserts that the Board should determine that: (i) applicant does not have the exclusive right to use the mark FABIANO'S on "homemade candies"; (ii) opposer possesses equal or superior rights in the mark; (iii) FABIANO'S is primarily merely a surname not registrable absent evidence of acquired distinctiveness; (iv) applicant cannot show acquired distinctiveness due to the lawful use of the mark by others; and (v) opposer holds written consent to register the name FABIANO'S as a mark from the living individual who is identified by the mark.

Applicant's Position

Not surprisingly, applicant, based on the same facts and the same documents, reaches a different conclusion. Specifically, applicant's position is that it began its continuous use of the mark FABIANO'S for homemade candies in 1980 through Michael and Jane Fabiano, who sold the name and the business to their daughters Kathleen Ghinelli and

now call their store "The Peanut Barrel or something like that."
(Madeline Blair dep., pp. 13-14.)

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Madeline Blair in 1984; and that the sisters operated as a partnership until 1995, when they converted the partnership to a corporation (applicant corporation). Kathleen Ghinelli subsequently sold her entire share of the corporation in 2000 (as well as her share of the second partnership, Fabiano's Candy Kitchen) to Steve Blair.

Applicant argues that Michael and Jane Fabiano sold their rights in not only the trade name FABIANO'S HOMEMADE CANDIES but also in the surname mark FABIANO'S in the 1984 sale to Kathleen Ghinelli and Madeline Blair; that the 1984 written contract is clear (including its reference to the "name" and "goodwill") and it would be illogical to assume that purchasers would pay for the words "homemade candies" as the name and mark for a homemade candy business; that the surviving founder, Jane, relinquished all rights in and to the use of FABIANO'S for use on homemade candies and any related goods and/or services, i.e., she retained no rights in FABIANO'S as a mark; and that Jane Fabiano thus had nothing to sell, transfer or consent to use with respect to the mark FABIANO'S.

Alternatively, applicant argues that if, as argued by opposer, the term was a surname and not a protectable trademark, then Michael and Jane Fabiano also had no protectable right therein when they sold it in 1984 (only four years after their first use) and that because Jane

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Fabiano has not been in business for herself since that date, she had no rights in the mark FABIANO'S to transfer to Paul Ghinelli in 1997, which is a date inferior to applicant's first use.

Applicant contends that opposer (Fabiano's Sweet Shoppe, LLC) also does not have superior rights or priority of use over applicant because Kathleen Ghinelli sold all of her stock in applicant corporation and thus all of her rights in the mark in 2000, so that she therefore had no rights to transfer; and that opposer did not receive any rights in or title to the mark FABIANO'S from Paul Ghinelli as he did not own the rights to the mark.

Alternatively, applicant contends that if, as argued by opposer, the term FABIANO'S was a surname and not a protectable trademark, then Paul Ghinelli's use of the name as a mark could not have acquired distinctiveness within three years when he sold to opposer company (his sister); that the bill of sale from Paul Ghinelli to opposer does not even reference a name or mark and makes no reference to the goodwill thereof (since, as stated previously, the property list referred to in the document was not introduced into this record); and that, therefore, opposer's first use commences only as of April 2000 when opposer acquired the store and tangible "property" from Paul Ghinelli, which is a date inferior to applicant's first use.

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Applicant also argues that its (and its predecessors) use of the mark over 20 years has grown and is nationwide with total sales exceeding \$3.5 million, and advertising and promotional expenditures of about \$5000 - \$7000 per year; and that its mark FABIANO'S has acquired distinctiveness identifying applicant as the source of the goods.

Applicant acknowledges that it (through Kathleen Ghinelli and Madeline Blair, either individually or as equal shareholders of applicant corporation) gave Paul Ghinelli an oral consent to use the name FABIANO'S. But, applicant contends, this did not transfer rights in the mark and did not give Paul Ghinelli superior rights in the mark; that applicant (as a partnership and then as of 1995 as a corporation) was in business for 13 years prior to Paul Ghinelli's first use of the mark, and remains in business today; and that applicant provided products and packaging and the like to Paul Ghinelli in order to control the nature and quality of the goods and services offered at Paul Ghinelli's store.

Burden of Proof

The issue before us is not the parties' respective rights to use the mark, but rather whether applicant has a right to register the mark under the provisions of the Trademark Act. In Board proceedings, our primary reviewing Court has held that the plaintiff must establish its pleaded

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case (e.g., priority and likelihood of confusion), as well as its standing, and must generally do so by a preponderance of the evidence. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991); and *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

Discussion

Opposer has established its standing to bring this case inasmuch as it has proven that it uses the mark FABIANO'S as part of FABIANO'S SWEET SHOPPE for retail candy and ice cream store services and as a trademark for candy and ice cream. See *Cunningham v. Laser Golf Corp.*, supra.

With regard to opposer's claim that the mark FABIANO'S is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), this matter is not in dispute as applicant has acknowledged that its mark is primarily merely a surname by seeking registration under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). Applicant has never argued that the term FABIANO'S is not primarily merely a surname. Thus, the question becomes whether applicant has established acquired distinctiveness of the mark prior to the earliest date on which opposer can

rely. The acquired distinctiveness of surnames is generally demonstrated with a minimum of evidence. See Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f); Trademark Rule 2.41(b); and TMEP §1212.05(a) (3d ed. 2002). Here applicant has testified as to its use of the mark FABIANO'S for about 20 years (priority is fully discussed later herein), with sales of over \$3.5 million in that time; and it spends about \$5000 - \$7000 per year on advertising. We find this is sufficient to establish that applicant has acquired distinctiveness in the mark FABIANO'S for homemade candies. Prior to the earliest date on which opposer can rely (discussed infra), applicant had substantially exclusive and continuous use of the mark and thus acquired distinctiveness therein. Inasmuch as applicant has established acquired distinctiveness in the mark FABIANO'S, opposer's surname claim must fail.⁹

We turn next to opposer's claim that the mark FABIANO'S identifies a particular living individual, and that applicant does not have the written consent of that individual to register the mark. See Section 2(c) of the

⁹ We are mindful of opposer's argument that the mark does not identify applicant as the source of the goods because there were and are uses of the same surname by others (e.g., opposer, Paul Ghinelli and cousins). As fully addressed later in our discussion of the priority issue, we find that it is applicant who has the unbroken chain of title to the mark, and has priority of use over both opposer and Paul Ghinelli. Thus, the uses by opposer and Paul Ghinelli do not preclude applicant's registration of the mark. And the cousins in Holland, Michigan no longer use the mark FABIANO'S.

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Trademark Act, 15 U.S.C. §1052(c). The record before us does not support opposer's claim that "FABIANO'S" identifies a particular person with the surname "Fabiano," and specifically, Jane Fabiano. The record does show that Jane Fabiano was a co-founder of the original store in 1980; that she played a prominent role in the candy store; and that she continues to play a prominent role in her family. In particular, after Michael and Jane Fabiano sold the business to their two daughters, they both remained involved (until his death) in promoting the store (e.g., pictures of the whole family, and stories in local newspapers and city magazines. (Jane Fabiano dep., pp. 7-8.) According to Gina Ghinelli-Mulcahy, people come into opposer's store "just specifically for my *mother* and grandmother." (Italics emphasis added -- dep., p. 16.) The record does not support a finding that FABIANO'S is perceived by the relevant purchasing public as specifically identifying Jane Fabiano. The mark could also identify Michael Fabiano, or his and Jane's original "FABIANO'S" store, or other members of the "Fabiano" family, including those in Holland, Michigan. Accordingly, opposer's claim under Section 2(c) must fail.

We turn then to opposer's claim of priority of use and likelihood of confusion. Applicant has applied to register the mark FABIANO'S for "homemade candies." Opposer has established that it uses the mark FABIANO'S SWEET SHOPPE for

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a retail store featuring homemade ice cream and homemade candy and for the candy and ice cream. The marks are highly similar; and the parties' goods include an identical item, specifically, candy. The parties both assert that there is a likelihood of confusion. We find that there is a likelihood of confusion in this case where highly similar marks are used by opposer and applicant on and in connection with the same goods and related services.¹⁰ See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The question here is one of priority of use and, as explained above, it is opposer who bears the burden of proving its priority. Surnames have been placed into the category of non-inherently distinctive terms which require proof of acquired distinctiveness for protection. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §13:2 (4th ed. 2001); and 1 Jerome Gilson, Trademark Protection and Practice, §2.03[4][d] (2004). That is, surnames acquire legally protectable status as marks only after they have had such an impact upon a substantial

¹⁰ Madeline Blair testified that there have been instances of consumer complaints to applicant corporation regarding the quality of the candy and the ice cream at opposer's store (dep., pp. 42-43); and that she has to explain it is an independent store.

Gina Ghinelli-Mulcahy testified that in the past there have been instances when customers coming into her store were "not happy" with the candy from applicant's store, but that it has "been a long time" since that has occurred as "the public is starting to realize we're separate." (Dep., p. 18.)

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part of the buying public as to have acquired distinctiveness. See *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (CCPA 1953). And, proof of a prior proprietary right is, of course, a requirement for opposer to prevail here.

There is no doubt that FABIANO'S is the possessive form of the original family surname (although "Fabiano" is not the surname of any individuals now involved in either applicant or opposer, with the exception of Jane Fabiano¹¹); that the grandparents (Michael and Jane Fabiano) first used the mark FABIANO'S HOMEMADE CANDIES for their retail candy store and for the candy sold there commencing in 1980; that they sold such business to their two daughters (Madeline Blair and Kathleen Ghinelli) in 1984; and that this family has ultimately fractured into two sides over the question of who is entitled to use and register the mark FABIANO'S for homemade candies.

Opposer's theory of its priority of use is flawed because, inter alia, of the clear language of the 1984 bill of sale from Michael and Jane Fabiano to their two daughters. The 1984 sale of the store clearly included the FABIANO'S name and appurtenant goodwill. We do not agree with opposer that Michael and Jane Fabiano retained their

¹¹ "Fabiano" was the maiden name of Kathleen Ghinelli and Madeline Blair, but neither of them uses their maiden name as their surname.

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trademark rights in the surname "Fabiano" and/or the mark FABIANO'S. (Also, Jane Fabiano did not retain rights in the name/mark such that years later she could give consent to use and register the mark to the Ghinelli branch of the family.) Thus, the mark FABIANO'S became the property of the Kathleen Ghinelli and Madeline Blair partnership from 1984 until 1995, and when the partnership was converted to a corporation (i.e., applicant corporation -- Fabiano's Homemade Candies, Inc.), the rights therein transferred to applicant corporation. In April 2000, Kathleen Ghinelli clearly sold her entire interest in applicant corporation and terminated her relationship therewith. Kathleen Ghinelli retained no rights in the name/mark FABIANO'S. From the documentation before this Board there is no doubt that the chain of title in the mark FABIANO'S rests with applicant corporation.

Although applicant assisted Paul Ghinelli in setting up his store, there is no evidence of a transfer of applicant's rights in the mark FABIANO'S to Paul Ghinelli in 1997. There is evidence that applicant allowed Paul Ghinelli to use the mark, but we find it is supported and is reasonable, as applicant contends, that applicant was caught in a family matter, and was attempting to control the nature and quality of the goods and services on and in connection with which Paul Ghinelli used the mark FABIANO'S. Thus, Paul Ghinelli,

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having acquired no ownership rights in the mark FABIANO'S from applicant corporation, had no such rights to sell in 2000 when he sold his store to opposer company. Moreover, and in fact, the April 8, 2000 bill of sale from Paul Ghinelli to opposer company does not make any reference at all to the sale of any mark and appears to refer only to tangible "property" at a specific address (the list of property which was not made of record herein). See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §18:2 (4th ed. 2001), and cases and authorities therein.

Thus, we find that applicant has had continuous use of the mark FABIANO'S since 1980 based on the original owners' use thereof. Opposer, on the other hand, has established first use of the mark FABIANO'S SWEET SHOPPE only as of April 2000.

On this record, opposer has not proven priority of use of the mark, and opposer's likelihood of confusion claim must fail.¹²

¹² As a postscript to this opposition proceeding, we note Professor McCarthy's discussion about various courts' attempts at compromise in litigation involving personal names. See generally, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §13:9 (4th ed. 2001). In his discussion, Professor McCarthy highlights a conflict between two competing policies: the policy of protecting the senior user and the consumer from injury resulting from a likelihood of confusion where similar marks are used versus the policy of recognizing the limited "right" of a person to use his or her own personal name as a trade symbol. Regarding the limitations of a person's "right" to use the family name, and particularly the more

Decision: The opposition is dismissed.

"modern" balancing of these competing policies, see *Perini Corp. v. Perini Construction Inc.*, 915 F.2d 121, 16 USPQ2d 1289, 1291 (4th Cir. 1990); *Basile S.p.A. v. Basile*, 899 F.2d 35, 14 USPQ2d 1240, 1243 (CADC 1990); *Levitt Corp. v. Levitt*, 593 F.2d 463, 201 USPQ 513, 516 (2nd Cir. 1979); *Taylor Wine Co., Inc. v. Bully Hill Vineyards, Inc.*, 569 F.2d 731, 196 USPQ 593, 595 (2nd Cir. 1978); and *Ford Motor Co. v. Ford*, 462 F.2d 1405, 174 USPQ 456, 458 (CCPA 1972).

The Board lacks the power to fashion such a remedy in determining the right to register.